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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,634	03/09/2001	Shimon Shmueli	4989-005	8535

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EXAMINER	
FADOK, MARK A	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/802,634	SHMUELI ET AL.	
	Examiner	Art Unit	
	Mark Fadok	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-19 and 21-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-19 and 21-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/31/2006*.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *9/30/2006* .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 6/7/2006, which was received 8/17/2006. Acknowledgement is made that no amendments were provided, leaving claims 1-7,9-19 and 21-27 as pending in the instant application. Applicant's remarks have been carefully considered and were found to be persuasive, however, after further searching the following new grounds of rejection follows:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3,6,7,9-15,18,19,21-23,26 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda (US 5,884,271) in view of TERGEON (US 20020029254) and further in view of Official Notice.

In regards to claim 1, Pitroda discloses a portable device comprising:

a body (FIG 1);

memory within the body containing software and financial account information (FIG 3);

an interface associated with the memory and adapted to facilitate interaction with a host computing device during a computing session (FIG 30, col 10, lines 40-45);

the software adapted to execute on the host computing device to instruct the host computing device (col 10, lines 40-50 and FIG 4) to:

Pitroda teaches the use of stored financial information on a UET to conduct a transaction over the internet (FIG 2) and also teaches programming the portable device for special application. Pitroda does not however specifically mention that the financial fields of a web page are recognized and financial fields are filled in during the web based transaction. Arnold teaches using a ancillary computing device to analyze web page fields and fill in the appropriate fields. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include auto fill functionality

within the UET for the obvious reason that auto form filling saves time and is more accurate than manual filling of forms.

automatically execute on the host computing device in association with the computing session (FIG 4, initialization and I/O drivers, item 419 & 422). Applicant may argue, however, that Pitroda does not specifically mention auto execution on the PC. As stated in applicant's specification (page 6, line 30 – page 7, line 15) auto run capability is old and well known in the art, the examiner additionally takes official notice that automatically executing a remote device on a host device is old and well known in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Pitroda an auto-execute program because this will simplify the accessing of the remote application by not requiring the devices application to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device. and

Pitroda teaches secure transactions over the internet via a PC, but does not specifically mention that residual data is flushed from the client PC. Turgeon teaches flushing the PC memory to remove data after use in a transaction (FIG 5, item 521). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Pitroda erasing the memory in the client PC, because this will improve the security of sensitive data by not allowing the data to reside on a device that is not secure.

In regards to claim 2, Pitroda teaches wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

query a user to select one of the plurality of financial accounts (FIG 4);

receive selected indicia from the user (FIG 13); and

fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts (FIG 16).

In regards to claim 3, Pitroda teaches wherein the software is further adapted to provide an authentication routine to execute on the host computing device,

the authentication routine instructing the host computing device to receive authentication indicia from a user via an interface on the host computing device (FIG 11) and

determine if the authentication indicia received from the user matches authentication indicia stored on the portable device (col 14, lines 7-18).

In regards to claims 6 and 7, Petridis teach the data filling objects in regards to financial data (see claims 1 and 2 above), but does not specifically mention that the data being processed is shipping information. Since the limitation of shipping information does not impart any functionality this limitation is considered to be non-

functional descriptive material (see MPEP 2106(b)) and is therefore not considered to provide patentable distinction. The examiner contends that the system would work equally well with the auto filling of any type of data.

In regards to claim 9, Pitroda teaches wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device (FIG 4).

In regards to claim 10, Pitroda teaches wherein the software is adapted to appear as a file system to the host computing device (FIG 4).

In regards to claim 11, Pitroda teaches wherein the interface is adapted to directly interface a port in the host computing device (UET and CIU).

In regards to claim 12, Pitroda teaches wherein the interface is adapted to provide a wireless interface with the host computing device (col 10, lines 4-25).

Claims 4,5,16,17,24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda (US 5,884,271) in view of TERGEON (US 20020029254) in view of Inala (US 6,199,077) and further in view of Official Notice.

In regards to claim 4, Pitroda teaches storing applications on a portable device that can be activated on a PC, but does not specifically mention that the application is one that activates an auto login to a second web page. Inala teaches an auto login feature (FIG 5). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Pitroda an application for auto logging because this would save the user time and provide a automatic and transparent access to restricted websites to the user.

In regards to claim 5, Pitroda teaches wherein a bookmark for the web page is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing to make the bookmark accessible by the browser running on the host computing device such that a user may use the bookmark to efficiently access the web page via the browser (Inala, col 8, lines 15-30).

In regards to claims 13-19 and 21-27, these claims are considered to be parallel claims to claims 1-8 and are rejected for the same rationale.

Second 103 Rejection

The examiner in an effort to map for the applicant all the best art cited is also providing the following rejection in view of Davis.

Claims 1-7,9-19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 20020029254) in view of Arnold, in view of TERGEON and further in view of Official Notice.

In regards to claim 1, Davis discloses a portable device comprising:

a body (FIG 4, item 410);

memory within the body containing software and financial account information (para 0036);

an interface associated with the memory and adapted to facilitate interaction with a host computing device during a computing session (FIG 7);

the software adapted to execute on the host computing device to instruct the host computing device (para 0036) to:

Davis teaches the use of wallet applications on a smart card with server like functionality to conduct transactions over the internet (FIG 5) and also teaches processing applications from the smart card on a client device (para 0043) along with functionality to populate a vendor site with credit card information (para 0059). Davis does not however, specifically mention that the financial fields of a web page are recognized and financial fields are filled in during the web based transaction. Arnold teaches using a ancillary computing device to analyze web page fields and fill in the appropriate fields. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include auto fill functionality in Davis's smart card for the

obvious reason that auto form filling saves time and is more accurate than manual filling of forms.

Davis teaches the use of multiple user applications (para 0031) but does not specifically mention auto execution on the PC. As stated in applicant's specification (page 6, line 30 – page 7, line 15) auto run capability is old and well known in the art, the examiner additionally takes official notice that automatically executing a remote device on a host device is old and well known in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis an auto-execute application on the server like s\mart card of Davis, because this will simplify the accessing of the remote application by not requiring the device to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device. and

Davis teaches secure transactions over the internet via a PC, but does not specifically mention that residual data is flushed from the client PC. TUGREON teaches flushing the PC memory to remove data after use in a transaction (FIG 5, item 521). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Davis erasing the memory in the client PC, because this will improve the security of sensitive data by not allowing the data to reside on a device that is not secure or will be usable by another at a latter time.

In regards to claim 2, Davis teaches wherein the financial account

information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

query a user to select one of the plurality of financial accounts (FIG 8C);

receive selected indicia from the user (FIG 8C); and

fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts (see response to claim 1).

In regards to claim 3, Davis teaches server like functionality on a smart card, the use of passwords to access applications and the further use of a password to access critical data (FIG 8B), but does not specifically mention that the access to the smart card is controlled by an authentication routine. The examiner takes official notice that the use of authentication routines to access secure information was old and well known in the art at the time of the instant invention. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis an authentication routine, because this would assure that only users authorized access to the secure information are permitted to access and use the secure information from the smart card.

In regards to claim 4, Davis teaches wherein the portable device stores login information for a second web page associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login

information is necessary for the second web page and provide the login information upon entering the second web page (para 0060).

In regards to claim 5, Davis teaches wherein a bookmark for the web page is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing to make the bookmark accessible by the browser running on the host computing device such that a user may use the bookmark to efficiently access the web page via the browser (FIG 8B).

In regards to claim 6, Davis teaches within the portable device stores shipping information for a item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web page to facilitate delivery of the item selected for purchase (FIG 8A).

In regards to claim 7, Davis teaches wherein the shipping information includes a plurality of shipping addresses, the software further adapted to instruct the host computing device to:

query a user to select one of the plurality of shipping addresses ;

receive selection indicia from the user (FIG 8D); and

fill in the shipping address fields with certain of the shipping information

corresponding to the selected one of the plurality of shipping addresses See response to claim 1).

Further, in regards to claims 6 and 7, Davis teaches the data filling objects in regards to financial data (see claims 1 and 2 above), but does not specifically mention that the data being processed is shipping information. Since the limitation of shipping information does not impart any functionality this limitation is considered to be non-functional descriptive material (see MPEP 2106(b) and is therefore not considered to provide patentable distinction. The examiner contends that the system would work equally well with the auto filling of any type of data.

In regards to claim 9, Davis teaches wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device (FIG 8A).

In regards to claim 10, Davis teaches wherein the software is adapted to appear as a file system to the host computing device (FIG 8A).

In regards to claim 11, Davis teaches accessing a client device using a smart card accepting device (para 0031).

In regards to claim 12, Davis teaches accessing a client device, but does not specifically mention that the client is accessed wirelessly. The examiner takes Official Notice that is was old and well known in the art at the time of the invention to use wireless technology to access client devices. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis, wireless technology, because this would offer another means of accessing a client device that might only have wireless access capability, thus incorporating this technology in the smart card would increase the usefulness of the Davis system and increase sales.

In regards to claims 13-19 and 21-27, these claims are considered to be parallel claims to claims 1-8 and are rejected for the same rationale.

Response to Arguments

Applicant's arguments, see reply to office action, filed 8/17/2006, with respect to the rejection(s) of claim(s) 1-7,9-19 and 21-27 under TERGEON have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Pitroda or Davis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey A. Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including
After Final communications labeled
"Box AF"]

For general questions the receptionist can be reached at
571.272.3600

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Mark Fadok

Primary Examiner